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In re Application of : DECISION ON
FLORIANO et al :
Application No.: 10/522,499 : PETITION
Filing Date: January 24, 2005 :
Attorney's Docket No.: 5936-11111 : UNDER 37 CFR 1.182
For: CAPTURE AND DETECTION OF MICROBES :
BY MEMBRANE METHODS :

This is in response to applicants' submission, "PETITION TO CONVERT A NATIONAL APPLICATION FILED UNDER 37 USC 371 TO AN APPLICATION FILED UNDER 35 U.S.C. 111(a)," filed 04 March 2005, which is being treated as a petition under 37 CFR 1.182. The petition requests the above referenced application be converted from a national stage application filed under 35 U.S.C. 371 to a national application filed under U.S.C. 111(a). The \$400.00 petition fee will be charged to Deposit Account No. 50-1505.

BACKGROUND

On 24 July 2003, applicants filed international application PCT/US03/23131, which claimed priority of earlier applications filed on 24 July 2002. The international application as filed contained a total of 73 claims. Claim 73 was cancelled during international preliminary examination. In response to the written opinion, applicants offered an amendment which added claims 74-80. However, applicant did not offer replacement sheets in compliance with PCT Rule 66.8. Accordingly the amendments were not considered when the international preliminary examination report was established. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 January 2005.

On 24 January 2005, applicants filed a transmittal letter (Form PTO-1390) for entry into the national stage in the United States which was accompanied by, inter alia, the basic national fee and a copy of the international publication. The papers were accompanied by a preliminary amendment that stated "Claims 50-54, 69, and 81-94 are currently pending. Claims 81-93 are new. Claims 1-49, 55-68 and 70-80 have been cancelled without prejudice." These papers were identified with attorney docket number 5936-11111. These papers were assigned an application number of 10/522,499.

Also on 24 January 2005, applicants filed a second set of papers which was accompanied by, inter alia, a transmittal letter (Form PTO-1390) for entry into the national stage in the United States which was accompanied by, the basic national fee and a copy of the international publication. The papers were accompanied by a preliminary amendment that stated "Claims 31-39, 41-49, 79, and 80 are currently pending. Claims 1-13, 15-30, 40, 50-71 and 74-78 have been cancelled without prejudice." These papers were identified with attorney docket number 5936-11112. These papers were assigned an application number of 10/522,926.

Additionally on 24 January 2005, applicants filed a third set of papers which was accompanied by, inter alia, a transmittal letter (Form PTO-1390) for entry into the national stage in the United States, the basic national fee and a copy of the international publication. The papers were accompanied by a preliminary amendment that stated "Claims 1, 2, 5, 8-13, 15-17, 22, 24, 28, 30, and 81-83 are currently pending. Claims 81-83 are new. Claims 3, 4, 6, 7, 18-21, 23, 25-27, 29, 31-71, and 74-80 have been cancelled without prejudice." These papers were identified with attorney docket number 5936-11110. These papers were assigned an application number of 10/470,646.

On 04 March 2004, applicants filed a petition to convert the above national stage application filed under 37 USC 371 to an application filed under 35 USC 111(a).

DISCUSSION

As is evident from the above recited facts, three sets of papers to enter the national stage were submitted for international application number PCT/US03/23131. The end result for an international application designating the United States of America is a single U.S. national stage application. Therefore, the submission of three sets of national stage papers to enter the United States was improper. The USPTO has treated application number 10/522,296 as the national stage of international application PCT/US03/23131.

Applicants have submitted papers that, inter alia, request the above-captioned application (Docket No. 5936-11111) be processed as a continuation of the U.S. National Phase application based on PCT/US03/23131. This request is being treated as a petition under 37 CFR 1.182.

A review of the papers filed 24 January 2005 reveals that a copy of the international application and a preliminary amendment were submitted. This is sufficient to meet the requirements of a filing under 35 U.S.C. 111(a).

The \$400.00 petition fee will be charged from Deposit Account No. 50-1505 as authorized.

Applicants are entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application

(U.S. Serial No. 10/522,499) and the international application (PCT/US03/23131) designating the United States were copending on 24 January 2005.

Applicants are entitled to claim benefit under 35 U.S.C. 119(e) of the filing date of the provisional applications for the common subject matter, since the international application (PCT/US03/23131) claimed benefit to these applications. In order to obtain benefit of the earlier international application, applicants must make reference to the previous application and state the relationship. The required reference may either be in an application data sheet, or the specification must contain or be amended to contain such reference in the first sentence. An appropriate passage would be, "International application PCT/US03/23131 claims the benefit of U.S. Provisional Application No. 60/---,--- filed ----- -- -- and U.S. Provisional Application No. 60/---,--- filed ---- -- ---, etc." Applicants must provide this reference within four (4) months from the filing date of this application. See 37 CFR 1.78(a)(5)(ii). If the reference to the prior application is supplied later than 4 months from the filing date, the reference must be accompanied by a petition fee and petition to accept an unintentionally delayed claim under 37 U.S.C. 119(e). See 37 CFR 1.78(a)(6).

CONCLUSION

Applicants' petition under 37 CFR 1.182 is hereby GRANTED.

This application is being forwarded to the Office of Initial Patent Examination (OIPE) for treatment as a filing under 35 U.S.C. 111(a) with a filing date of 24 January 2005, which is a continuation of international application PCT/US03/23131 filed 24 July 2003.



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